

REMARKS

This paper responds to the Office Action mailed on May 15, 2007. Claims 15-37 are canceled such that claims 1-2 and 4-14 are now pending in this application.

Election/Restrictions

As required by the Examiner, the claims of the non-elected invention (i.e., claims 15-37) are hereby canceled. However, Applicant reserves the right to later file continuations or divisionals having claims directed to the non-elected inventions.

§102 Rejection of the Claims

Claims 1-2, 4, 7 and 8 were rejected under 35 U.S.C. § 102(b) for anticipation by Zhang et al. (US 5,658,583). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Office Action states at page 2 that “Zhang et al. discloses a heat patch comprising of an enclosure having gas-permeable first layer (26) and second layer (16) bonded together . . .” Applicant respectfully traverses the assertion because reference numeral 26 refers to openings in a structure 22 which caps heat generating chamber 14. (See col. 6, lines 3-9 of Zhang). Applicant also respectfully directs the Examiner’s attention to col. 5, lines 54-59; col. 6, lines 43-44 and FIG. 1 of Zhang which demonstrate that the enclosure for the heat-generating chamber is formed of structure 22 and non-permeable wall 16.

Applicant further notes that while the perimeter of the non-permeable wall 16 is attached to structure 22, the perimeter of structure 22 is not attached to non-permeable wall 16. Therefore, Applicant respectfully submits that Zhang does not teach or suggest “an enclosure

that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” as recited in claim 1.

Claims 2, 4, 7 and 8 depend from claim 1 such that these claims incorporate all the limitations of claim 1. Therefore, Zhang does not teach or suggest the subject matter of claims 2, 4, 7 and 8 for at least the reasons provided above with regard to claim 1.

Reconsideration and allowance of claims 1-2, 4, 7 and 8 are respectfully requested.

First §103 Rejection of the Claims

Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. in view of Argaud (US 4,963,360). Applicant respectfully traverses the rejection because the combination of Zhang and Argaud does not describe each and every element of the claimed invention. As discussed above, Zhang does not teach or suggest “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” as recited in claim 1.

Applicant notes that Argaud also does not describe “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” as recited in claim 1. Claims 5-6 depend from claim 1 and as such incorporate all of the limitations of claim 1. Therefore, Applicant respectfully submits that the combination of Zhang and Argaud does not teach or suggest a heat patch as recited in claims 5-6.

Second §103 Rejection of the Claims

Claims 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. in view of Kuratomi (US 4,747,841). Applicant respectfully traverses the rejection because the combination of Zhang and Kuratomi does not describe each and every element of the claimed invention.

As discussed above, Zhang does not teach or suggest “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” as recited in claim 1. Applicant notes that Kuratomi does not describe “wherein said entire first layer is gas-permeable” as recited in claim 1.

Claims 9-12 depend indirectly from claim 1 and as such incorporate all of the limitations of claim 1. Therefore, Applicant respectfully submits that the combination of Zhang and Kuratomi does not teach or suggest a heat patch as recited in claims 9-12.

Third §103 Rejection of the Claims

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. as applied to claims 9-12, further in view of Ingram (US 5,366,491). Applicant respectfully traverses the rejection because the combination of Zhang, Kuratomi and Ingram does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Zhang, Kuratomi and Ingram.

I. Zhang, Kuratomi and Ingram do not teach or suggest every element of claim 13

As discussed above, Zhang and Kuratomi do not teach or suggest “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” in combination with “wherein said entire first layer is gas-permeable” as recited in claim 1. Applicant notes that Ingram also does not describe “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” in combination with “wherein said entire first layer is gas-permeable” as recited in claim 1.

Claim 13 depends from claim 1, and as such incorporates all of the limitations of claim 1. Therefore, Applicant respectfully submits that the combination of Zhang, Kuratomi and Ingram does not teach or suggest a heat patch as recited in claim 13 for the reasons argued above with regard to claim 1.

In addition, the Examiner acknowledges at page 6 of the Office Action that “however Zhang and Kuratomi do not disclose a heat patch having plurality of portions with information related to heat generated by the heat patch when one or more portions is removed from the first layer.” The Examiner attempts to overcome the acknowledged deficiencies of Zhang and Kuratomi by combining Zhang and Kuratomi with Ingram.

Applicant notes that the liquid crystal temperature-indicating strip (22) disclosed in Ingram monitors and displays the temperature of the skin. Applicant initially submits that the strip 22 is not attached to a gas-permeable first layer.

In addition, the disclosed strip 22 is not meant to be removed from the heat pack 1 such that (i) the strip 22 is not detachably connected to the heat patch 1; and (ii) the strip does not provide information as to what happens when the strip 22 is removed because the strip is not meant to be removed. Applicant also submits that the strip 22 does not provide information as to what would happen if the strip 22 were removed from the heat pack 1. Therefore, Ingram does not describe “wherein at least one of said plurality of portions includes information related to heat generated by the heat patch when one or more of said plurality of portions is removed from said gas-permeable first layer” as recited in claim 13.

II. ***There is no motivation or suggestion to combine Zhang, Kuratomi and Ingram***

The Office Action states at page 7 that

“it would have been obvious to one skilled in the art to modify the heat patch of Kuratomi and Zhang to include the temperature indicating strip of the Ingram’s heat patch to allow monitoring the use of the heat patch for therapeutic level without damaging the user’s skin with higher temperature.”

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Mere conclusory statements are unsatisfactory.

“With respect to Lee’s application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner’s conclusory statements that ‘the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software’ and that ‘another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial’ do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use ‘[use] that which the inventor

taught against its teacher.’ *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).” *Lee*, at 1343, 1344.

Applicant respectfully submits that the Examiner’s statement regarding motivation is analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case. In addition, Applicant notes that the Examiner does not cite any authority for the assertion.

Applicant further submits that the only teaching or suggestion as to (i) the entire first layer being gas-permeable; (ii) where the gas-impermeable cover includes a plurality of portions that are detachably mounted to the outer surface of the gas-permeable first layer; and (iii) one of the plurality of portions including information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer is found in Applicant’s specification and claims. Applicant also fails to see how the strip 22 disclosed in Ingram would display proper information if the strip 22 were removed from the heat pack 1 as recited in the claims.

It is respectfully submitted that the Examiner’s assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

Since there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claim 13 are respectfully requested.

Fourth §103 Rejection of the Claims

Claims 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. and Ingram, as applied to claim 13 above, further in view of Lachenbruch (US 6,755,852). Applicant respectfully traverses the rejection because the combination of Zhang, Kuratomi, Ingram and Lachenbruch does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Zhang, Kuratomi, Ingram and Lachenbruch.

I. Zhang, Kuratomi, Ingram and Lachenbruch do not teach or suggest every element of claim 14

As discussed above, Zhang, Kuratomi and Ingram do not teach or suggest “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” in combination with “wherein said entire first layer is gas-permeable” as recited in claim 1. Applicant notes that Lachenbruch also does not describe “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” in combination with “wherein said entire first layer is gas-permeable” as recited in claim 1.

Claim 14 depends from claim 1, and as such incorporates all of the limitations of claim 1. Therefore, Applicant respectfully submits that the combination of Zhang, Kuratomi, Ingram and Lachenbruch does not teach or suggest a heat patch as recited in claim 14 for the reasons argued above with regard to claim 1.

Applicant further notes that the color-coded temperature indicator disclosed in Lachenbruch monitors and displays the temperature of the wrap. Applicant initially submits that the color-coded temperature indicator is not attached to a gas-permeable first layer as recited in the claims.

In addition, the disclosed color-coded temperature indicator in Lachenbruch is not meant to be removed from the wrap such that (i) the color-coded temperature indicator is not detachably connected to the wrap; and (ii) the color-coded temperature indicator would not change colors if the color-coded temperature indicator were removed because the color-coded temperature indicator would not function properly if it were removed. Applicant also submits that the color-coded temperature indicator would not provide information as what happens to the temperature of the wrap when it is removed from the wrap as recited in the claims. Therefore, Lachenbruch does not describe “wherein at least some of said plurality of portions are different colors, the colors supplying said information related to heat generated by the heat patch when one or more of said plurality of portions is removed from said gas-permeable first layer” as recited in claim 14.

II. *There is no motivation or suggestion to combine Zhang, Kuratomi, Ingram and Lachenbruch*

The Office Action states at page 8 that:

“it would have been obvious to one skilled in the art to modify the heat patch of Kuratomi, Zhang and Ingram to include the color-coded temperature indicator which is taught by Lachenbruch to be able to easily see the temperature change on the skin to have fastest response to remove it if temperature rise above the desirable temperature for therapy.”

Applicant respectfully submits that the Examiner’s statement regarding motivation is again analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case (see quote from *Lee* case above). In addition, Applicant notes that the Examiner does not cite any authority for the assertion.

Applicant respectfully submits that the only teaching or suggestion as to (i) the entire first layer being gas-permeable; (ii) where the gas-impermeable cover includes a plurality of portions that are detachably mounted to the outer surface of the gas-permeable first layer; (iii) one of the plurality of portions including information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer; and (iv) where at least some of the plurality of portions are different colors with the colors supplying information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer is found in Applicant’s specification and claims. Applicant also fails to see how the color-coded temperature indicator disclosed in Lachenbruch would provide information related to the wrap if it is removed from the wrap as recited in the claims.

It is respectfully submitted that the Examiner’s assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

Since there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claim 14 are respectfully requested.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record is relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

RICKY W. PURCELL

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(262) 646-7009

By / Andrew Peret /
Andrew R. Peret
Reg. No. 41,246

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19 day of June 2007.

CANDIS BUENDING

Name

Candis Buending
Signature